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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,367	04/07/2000	John Piechnick	6125/54125	1304
7590	06/04/2002		EXAMINER	
Coudert Brothers 600 Beach Street San Francisco, CA 94109			NGUYEN, TUYEN T	
		ART UNIT	PAPER NUMBER	
		2832		
				DATE MAILED: 06/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.  
09/545,367

Applicant(s)

Piechnick

Examiner  
Tuyen T. Nguyen

Art Unit  
2832



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on Feb 26, 2002
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.
- 4)  Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-16 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on 4/7/00 is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1)  Notice of References Cited (PTO-892)      4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      5)  Notice of Informal Patent Application (PTO-152)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_      6)  Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the *flange of first bobbin member for increasing creepage distance* must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant fails to disclose an adequate written description of the first bobbin member flange for increasing the creepage distance.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 15, there is no antecedent basis for “the creepage distance.” Applicant should clarify the flange structure of the first bobbin member for increasing the creepage distance.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4, 5, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Cook et al. [US 4,000,483].

Cook discloses the claimed invention [see paragraph 4 of the previous office action mailed 11/7/01].

***Claim Rejections - 35 USC § 103***

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. in view of Estrov [US 5,010,314].

See paragraph 6 of the previous office action mailed 11/7/01.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. in view of Dobberstein [US 4,549,130].

See paragraph 7 of the previous office action mailed 11/7/01.

11. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. in view of Eng, Jr. et al. [US 4,857,878].

Regarding claim 6, Cook et al. in view of Eng, Jr. et al. discloses the claimed invention [see paragraph 8 of the previous office action mailed 11/7/01].

Regarding claim 9, Cook et al. discloses the instant claimed invention except for a tubular portion extending away from the first body portion.

Eng, Jr. et al. discloses a tubular portion [204, 205] extending from a bobbin [200].

It would have been obvious to one having ordinary skilled in the art at the time the invention was made to use the tubular portion design of Eng, Jr. et al. in Cook et al. for the purpose of aligning the core within the bobbin structure.

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12. Claims 7-8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. in view of Equi et al. [US 4,939,623].

See paragraph 9 of the previous office action mailed 11/7/01.

13. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. in view of Equi et al. as applied to claims 10-13 above, and further in view of Eng, Jr. et al. [US 4,857,878].

Cook et al., as modified, discloses the instant claimed invention except for the second bobbin member including a plurality of pins.

Eng, Jr. et al. discloses first and second bobbins having a plurality of terminal pins disposed thereon [see figure 2].

It would have been obvious to one having ordinary skilled in the art at the time the invention was made to include a plurality of terminal pins of the second bobbin of Cook et al., as modified, as suggested by Eng, Jr. et al., for the purpose of providing connection for the secondary winding.

### ***Response to Arguments***

14. Applicant's arguments filed 2/26/02 have been fully considered but they are not persuasive.

Applicant argues that:

[1] Cook et al. fails to show a flange on one of the axially spaced walls of the second bobbin member *partially enclosing* the first bobbin member.

[2] There is no motivation to combine the teaching of Estrov with Cook et al.

[3] Examiner uses impermissible hindsight to the shield design of Dobberstein.

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[4] Cook et al. teaches away from a transformer structure having pins.

[5] Equi et al. does not teach the second bobbin member including a structure for receiving a PCB disposed on a flange thereof and side region thereof.

[6] Cook et al., as modified, does not show the specific mounting of the structure for receiving the PCB.

The examiner disagrees.

Regarding [1], Cook et al. shows a flange on one of the axially spaced walls of the second bobbin member *partially enclosing* the first bobbin member [see element 30 of figures 1-2].

Regarding [2], a skilled artisan would have been motivated to use the *substantially* perpendicular design of Estrov for the flanges of Cook et al. to accommodate multiple core types as acknowledged by applicant specification amendment.

Regarding [3], in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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Regarding [4], Eng, Jr. et al. shows pin structure on the bobbin members [see figure 1]. A skilled artisan wanting to surface mount a transformer on a PCB would have been motivated to use a pin design.

Regarding [5], Equi et al. discloses a structure for receiving a PCB disposed on a flange of a bobbin in a side region thereof [see figures 2-3].

Regarding [6], the specific housing design shown by Cook et al. is not required.

### ***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tuyen T. Nguyen whose telephone number is (703) 308-0821.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Elvin Enad, can be reached at (703) 308-7619. The fax number for this Group is (703) 305-7724.

Any inquiry of a general nature or relating to status of this application of proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

TTN *TTN*

May 29, 2002

*Tuyen T. Nguyen*